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10/674,056	09/29/2003	Georges R. Harik	Google-38 (GP-100-00-US)	1182
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STRAUB & POKOTYLO 788 Shrewsbury Avenue TINTON FALLS, NJ 07724			PADMANABHAN, KAVITA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,056	Applicant(s) HARIK, GEORGES R.	
	Examiner Kavita Padmanabhan	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 29-33 and 57-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 29-33 and 57-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/23/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 1, 29, 57, 61, 62, and 66 have been amended.
2. Claims 1-5, 29-33, and 57-78 are pending.
3. Claims 1-5, 29-33, and 57-78 are rejected.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 67-70, 72-74, and 76-78** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to **claims 67-70**, there does not appear to be support in the applicant's original specification for the limitation "*the predetermined number of the second plurality of search results is independent of a number of ads included on the generated search result page*" or "*the predetermined number of the second plurality of search results is more than a number of the ads included on the generated search result page*". The applicant has pointed to pages 10 and 11 as containing support for these claims, but no such support appears in those sections of the specification.

With respect to **claims 72 and 76**, there does not appear to be support in the applicant's original specification for the limitation "*the ad creative information is determined using information automatically extracted from an advertiser Web page*". The applicant has pointed to Fig. 3 and page 16, lines 1-19 as containing support for these claims, but no such support appears in those sections of the specification.

With respect to **claims 73 and 77**, there does not appear to be support in the applicant's original specification for the limitation "*the ad creative information is determined using a text snippet of the corresponding search result*". The applicant has pointed to Fig. 3 and page 16, lines 1-19 as containing support for these claims, but no such support appears in those sections of the specification.

With respect to **claims 74 and 78**, there does not appear to be support in the applicant's original specification for the limitation "*the ad creative information includes information automatically extracted from an advertiser Web page*". The applicant has pointed to Fig. 3 and page 16, lines 1-19 as containing support for these claims, but no such support appears in those sections of the specification.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 29-33 and 62-66** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a test of whether the invention is categorized as a process, machine, manufacture or composition of matter and if the invention produces a useful, concrete and tangible result. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) are found to be non-statutory subject matter. For a method claim to pass muster, the recited process must produce a useful, concrete and tangible result.

In the instant case, **claim 29** recites an apparatus, however it appears that the claimed means could consist purely of software per se, which is nonstatutory. **Claims 30-33 and 62-66** are similarly rejected.

The examiner will apply prior art to these claims as best understood, with the assumption that applicant will amend to overcome the stated 101 rejections.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. **Claims 1-5, 29-33, and 57-78** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rorex et al.** (US 6,876,997, hereinafter “Rorex”) **in view of Davis et al.** (US 6,269,361, hereinafter “Davis”).

In regards to **claim 1**, **Rorex** teaches a method for generating information for an online advertisement, the method comprising:

a) generating a first plurality of search results using a search query and an index of advertiser Web page information (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31 – “pay for placement database ... contains an ordered collection of search listing records used to generate search results in response to user queries.” – the ordered collection of search listing records used to generate the search results is interpreted to be an index of advertiser web page information**);

b) determining, for each of the first plurality of search results, at least one of (A) landing page information (**Rorex; col. 4, lines 33-46 – “generates a list of HyperText links to documents that contain information relevant to search terms entered by the user” – the document to which the link directs the user is interpreted to be a landing page, and the landing page information, i.e. the link and the associated document/landing page, are determined using the results of the user’s search terms**) and (B) ad creative information using a corresponding one of the first plurality of search results;

c) generating, for each of the first plurality of search results, an ad using the determined at least one of a landing page information and ad creative information (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57 – the paid search result listings are ads that are used to advertise a particular advertiser’s product to the user, which is why an advertiser pays for placement of their web page in the search result listings, because it serves as an advertisement to attract users to a particular advertiser’s product**); and

d) generating a search result page including

i) at least a second plurality of search results corresponding to the search query (**Rorex; col. 5, lines 58-65; col. 7, lines 35-38**), and

ii) the generated ads (**Rorex; col. 4, lines 33-46, 52-58; col. 5, lines 16-31, 52-57 – “The searcher may click on HyperText links associated with each listing in that search result page to access the corresponding web pages. The HyperText links ... include paid listings to advertiser web pages” – the paid listings to advertiser web pages constitute ads**),

wherein the generated ads are maintained as distinct from the second plurality of search result on the search result page (**Rorex; Fig. 3a; col. 6, line 60 – col. 7, line 8; col. 5, lines 58-65; col. 7, lines 35-38; applicant’s specification at p11, lines 18-20 states “preferably, the search results are maintained as distinct from the ads, so as not to confuse the user between paid advertisements and presumably neutral search results”, and Rorex at col. 5, lines 58-65 states “non-paid listings follow the paid advertiser listings on the search results page”, which clearly meets not only the claimed limitation, but also its stated purpose as per the applicant’s specification; in Rorex, the examiner is interpreting the non-paid listings on**

the search result page to be the second plurality of search results, which are displayed following the paid listings, i.e. ads, on the search result page and are thereby kept distinct from them).

Rorex does not expressly teach the second plurality of search results being a predetermined number.

Davis teaches unpaid listings being displayed after the paid listings to fill in the remainder of the 40 available slots in a search results page when there are an insufficient number of relevant paid listings (**Davis; col. 18, lines 26-36**). Therefore, the number of available slots for the unpaid listings is predetermined, based on the determined number of relevant paid listings, prior to displaying the listings.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the method of Rorex by including the teaching of Davis, whereby the number of unpaid listings is predetermined in an attempt to ensure that the searcher receives the most complete and relevant search results (**Davis; col. 5, lines 48-50**).

Claims 2-4 are rejected based on their dependency on claim 1. Claim 1 recites, "determining at least one of landing page information and ad creative information," and the reference teaches determining landing page information, whereas claims 2-4 seek to further limit the determination of ad creative information.

In regards to **claim 5**, **Rorex and Davis** teach the method of claim 1 wherein the landing page information is a URL included in the search result (**Rorex; col. 5, lines 38-45**).

In regards to **claim 58, Rorex and Davis** teach the method of claim 1 wherein the first plurality of search results and the second plurality of search results are generated by the same search operations (**Rorex; col. 7, lines 42-43 – same search terms/operators**).

In regards to **claim 59, Rorex and Davis** teach the method of claim 1 wherein the ads included on the generated search results page are ordered using a search score (**Rorex; col. 7, lines 12-34**).

In regards to **claim 60, Rorex and Davis** teach the method of claim 59 wherein the search score is a function of an information retrieval score (**Rorex; col. 7, lines 12-34**).

In regards to **claim 57, Rorex and Davis** teach the method of claim 1, wherein the predetermined number of the second plurality of search results is no less than a number of ads included on the generated search results page (**Davis; col. 18, lines 26-36 - the number of unpaid listings could obviously be equal to or greater than the number of relevant paid listings for any given search in an attempt to ensure that the searcher receives the most complete and relevant search results**).

In regards to **claim 61, Rorex and Davis** teach the method of claim 59.

Rorex and Davis do not expressly teach the search score being a function of a link analysis that assigns a numerical weighting to each element of a hyperlinked set of documents.

However, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to use PageRank to determine the search score in Rorex and Davis, since PageRank is a popular and well-known ranking methodology.

In regards to **claim 67, Rorex and Davis** teach the method of claim 1.

Rorex and Davis do not expressly teach the predetermined number of the second plurality of search results being independent of a number of ads included on the generated search result page.

However, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention that rather than filling the remaining available slots of Rorex and Davis with the unpaid listings, a fixed amount of the available slots could be reserved for unpaid listings, in order to provide the user with the most relevant listings.

In regards to **claim 68, Rorex and Davis** teach the method of claim 1 wherein the predetermined number of the second plurality of search results is more than a number of the ads included on the generated search result page (**Davis; col. 18, lines 26-36 - the number of unpaid listings could obviously be greater than the number of relevant paid listings for any given search in an attempt to ensure that the searcher receives the most complete and relevant search results**).

In regards to **claim 71, Rorex and Davis** teach the method of claim 1 wherein ad creative information is determined, for each of the first plurality of search results, and wherein the

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determined ad creative information is used to generate the ad for each of the first plurality of search results (**Rorex; col. 4, lines 52-61; Figs. 3A and 3B**).

In regards to **claim 72, Rorex and Davis** teach the method of claim 71 wherein the ad creative information is determined using information automatically extracted from an advertiser Web page (**Rorex; col. 4, lines 59-61; col. 5, lines 35-51 – URL and bid amount, for example**).

In regards to **claim 73, Rorex and Davis** teach the method of claim 71 wherein the ad creative information is determined using a text snippet of the corresponding search result (**Rorex; col. 4, lines 59-61; Figs. 3A and 3B**).

In regards to **claim 74, Rorex and Davis** teach the method of claim 71 wherein the ad creative information includes information automatically extracted from an advertiser Web page (**Rorex; col. 4, lines 59-61; col. 5, lines 35-51**).

Claims 29-33, 62-66, 69-70, and 75-78 are rejected with the same rationale given for claims 1-5, 57-61, 67-68, and 71-74, respectively.

Response to Amendment

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10. Applicant's amendments filed 2/27/08 with respect to the 35 USC 112, 2nd paragraph rejections have been fully considered. The corresponding objections have been withdrawn accordingly.

11. Applicant's amendments filed 2/27/08 with respect to the 35 U.S.C. 101 rejections have been fully considered. However, the rejections have been maintained. Applicant argues at pages 9-10 of applicant's remarks that software per se, without the benefit of processor(s) and/or storage devices, could not perform the function recited by the means-plus-function claim elements recited in claim 29. However, the examiner asserts that the processor(s) and/or storage devices are not being claimed and that page 4 of the amended specification filed on 7/6/07 recites in part, "The one or more processors 1010 may execute *machine-executable instructions ... to effect one or more aspects of the present invention*". Therefore, the means recited to implement the invention could clearly consist purely of software per se, i.e. machine-executable instructions, which is not statutory.

Response to Arguments

12. Applicant's arguments filed 2/27/08 with respect to the prior art rejections have been fully considered but they are not persuasive.

Applicant argues at page 12 of applicant's remarks that in Davis, the number of unpaid listings, i.e. the claimed second plurality of search results, is not predetermined. The examiner respectfully disagrees and asserts that predetermined is a broad term and that it is not clear based on the language of the claim what the number of search results in the second plurality of search results must be determined before in order to be considered predetermined. Therefore, the

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examiner asserts that, in Davis, the number of search results in the second plurality of search results is *determined before displaying* those search results, and are therefore *predetermined* with respect to display, as stated in the corresponding rejection above.

Applicant argues at page 13 of applicant's remarks that neither Rorex nor Davis teach that the predetermined number of unpaid listings is no less than a number of ads included on the generated search results page. The examiner respectfully disagrees with the applicant's argument and asserts that given the teachings of Rorex and Davis, it is obvious that the number of unpaid listings could be greater than a number of ads included on the search result page, which satisfies the claimed limitation of "no less than".

Applicant argues at page 13 of applicant's remarks that the ordering of ads in Rorex is solely dependent on the bid amount and does not take into account an information retrieval score. The examiner respectfully disagrees and asserts that Rorex states that "*Preferably, the rank value 360a-360i is assigned in a process, implemented in software, that establishes an association between the bid amount, the rank, and the search term of a search listing,*" (Rorex; col. 7, lines 17-20) and clearly teaches using information retrieval scores in ordering search results, as depicted by Fig. 5 of Rorex. Furthermore, the examiner asserts that the term "information retrieval score" is not defined in the applicant's specification in a manner that would preclude interpreting a ranking of search results based on relevancy and bidding from being considered an ordering based at least in part on information retrieval scores.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kavita Padmanabhan** whose telephone number is **(571)272-8352**. The examiner can normally be reached on Monday-Friday, 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Kavita Padmanabhan
Assistant Examiner
AU 2161

May 14, 2008

/K. P./

**/Apu M Mofiz/
Supervisory Patent Examiner, Art Unit 2161**